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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,287	11/03/2003	Rodney Carl Harris	10016459-1	4508
22879	7590	12/24/2008		
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER WILLS, LAWRENCE E	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 12/24/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/700,287

**Applicant(s)**

HARRIS ET AL.

**Examiner**

LAWRENCE E. WILLS

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 7-9, 11, 12, 14-22, 24, 25, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7-9, 11, 12, 14-22, 24, 25, 40, and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Response to Arguments**

1. Applicant's arguments with respect to claims 1, 17 and 40 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7, 11, 12, 17-20, 24, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent No. 7,295,339) in view of Ma (US Publication No. 2002/0102022).

Regarding claim 1, Kobayashi'339 teaches a method for enabling electronic document ratification (signed authentic documents, abstract), the method comprising: a printing device (fig. 7) receiving an electronic document transmitted to the printing device from a separate sending device via a network (electronic mail communication, column 12, line 40-42); the printing device adding the handwritten content to the electronic document without replacing original content of the electronic document (synthesize image data and signature information, S6, Fig.6). Kobayashi'339 fails to teach the printing device printing the electronic document to provide a recipient with a hard copy of the entire document upon which the recipient can write; the printing

device scanning handwritten content manually handwritten on the hard copy of the entire document by the recipient.

Ma'022 teaches printing the electronic document to provide a recipient with a hard copy (as shown in Fig. 2) of the entire document upon which the recipient can write (handwritten annotation, paragraph 0025) and scanning handwritten content manually handwritten on the hard copy of the entire document by the recipient (Fig. 8 and further, paragraph 0046);

Since Kobayashi printer already have a scanning capability (24, fig. 7), having a system of Kobayashi'339 reference and then given the well-established teaching of Ma'022 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Ma'022 reference because the result of the combination would have been predictable.

Regarding claim 17 and 40, Kobayashi'339 teaches a system for enabling electronic document ratification (signed authentic documents, abstract), the system comprising: a sending device configured to transmit an electronic document (communication apparatus, column 12, line 30-35); and a printing device configured to receive the electronic document transmitted by the sending device (communication apparatus, column 12, line 30-35), and to add only the handwritten content to the electronic document without replacing original content of the electronic document (synthesize image data and signature information, S6, Fig.6). Kobayashi'339 fails to teach to print the electronic document to provide a recipient with a hard

copy of the document upon which the recipient can write; to scan handwritten content of the printed document manually handwritten on the hard copy by the recipient.

Ma'022 teaches to print the electronic document to provide a recipient with a hard copy (as shown in Fig. 2) of the document upon which the recipient can write (handwritten annotation, paragraph 0025); to scan handwritten content of the printed document manually handwritten on the hard copy by the recipient (Fig. 8 and further, paragraph 0046).

Since Kobayashi printer already have a scanning capability (24, fig. 7), having a system of Kobayashi'339 reference and then given the well-established teaching of Ma'022 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Ma'022 reference because the result of the combination would have been predictable.

Regarding claim 7, Ma'022 (in combination with Kobayashi'339) teach wherein scanning handwritten content comprises the printing device only scanning the manually handwritten content (Fig. 8 and further, paragraph 0046).

Regarding claim 11, 24, and 41, Kobayashi'339 (in combination with Ma'022) teach wherein adding the handwritten content comprises the printing device adding the handwritten content within an input block of the electronic document (S5 and S6, Fig. 4).

Regarding claim 12, Kobayashi'339 (in combination with Ma'022) teach further comprising at least one of the printing device reprinting the electronic document after the handwritten content has been added (S8, Fig 4), transmitting the electronic document after the handwritten content has been added (signed mail transmitted, column 12, line 35), and storing the electronic document after the handwritten content has been added.

Regarding claim 18, Kobayashi'339 (in combination with Ma'022) teach wherein the printing device comprises at least one of a digital sender and a multi-function peripheral (MFP) device (column 11, 55-60).

Regarding claim 19, the combination of Kobayashi'339 (in combination with Ma'022) teach wherein the printing device comprises a multi-function peripheral (MFP) device configured to print, copy, scan, and transmit documents (Kobayashi'339 column 11, 55-60).

Having a system of Kobayashi'339 reference and then given the well-established teaching of Iggulden'723 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of signed-document creation system Kobayashi'339 reference to include scanning handwriting as taught by Iggulden'723 reference, since doing so would increase the versatility of the signed-document creation system.

Regarding claim 20, Kobayashi'339 (in combination with Ma'022) teach wherein the printing device comprises a document scanner (numbers 24, 25, Fig. 1).

4. Claims 8, 9, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent No. 7,295,339) in view of Ma (US Publication No. 2002/0102022) as applied to claims 1, 7, and 20 above, and further in view of Hart (US Patent No. 5,694,494).

Regarding claim 8 and 21, the combination of Kobayashi'339 and Ma'022 fail to teach wherein only scanning the manually handwritten content comprises the printing device only scanning handwritten content contained within an input block of the document.

Hart'494 teaches only scanning the manually handwritten content comprises the printing device only scanning handwritten content contained within an input block of the document (Fig. 6).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Hart'494 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17, and 40 above, to include scanning handwriting in a input block as taught by Hart'494 reference because the results of the combination would have been predictable.

Regarding claim 9 and 22, the combination of Kobayashi'339 and Ma'022 fail to teach wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received electronic document to identify the handwritten content was added by the recipient.

Hart'494 teaches wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received electronic document to identify the handwritten content was added by the recipient (comparing the two images with each other, column 4, line 48).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Hart'494 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17, and 40 above, to include the comparison techniques as taught by Hart'494 reference because the results of the combination would have been predictable.

5. Claims 3, 14-16, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 7,295,339) in view of Ma (US Publication No. 2002/0102022).as applied to claim 1 and 17 above, and further in view of Brown (US Patent 6,671,805).

Regarding claim 3, the combination of Kobayashi'339 and Ma'022 fail to teach wherein receiving an electronic document comprises the printing device receiving a PDF file.

Brown'805 teaches receiving an electronic document comprises the printing device receiving a PDF file (column 4, line 13).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of



signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17, and 40 above, to include a specific file format as taught by Brown'805 reference because the results of the combination would have been predictable.

Regarding claim 14, the combination of Kobayashi'339 and Ma'022 fails to teach the sending device identifying an input block of the electronic document prior to transmitting the electronic document to the printing device.

Brown'805 teaches the sending device identifying an input block of the electronic document prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17, and 40 above, to include input block identification as taught by Brown'805 reference because the results of the combination would have been predictable.

Regarding claim 15, the combination of Kobayashi'339 and Ma'022 fails to teach further comprising the sending device adding metadata to the electronic document that identifies that the electronic document is to be ratified prior to transmitting the electronic document to the printing device.

Brown'805 teaches the sending device adding metadata to the electronic document that identifies that the electronic document is to be ratified prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17, and 40 above, to include metadata as taught by Brown'805 reference because the results of the combination would have been predictable.

Regarding claim 16, the combination of Kobayashi'339 and Iggulden'723 fails to teach further comprising the sending device adding metadata to the electronic document that identifies a location of an input block of the electronic document prior to transmitting the electronic document to the printing device.

Brown'805 teaches comprising the sending device adding metadata to the electronic document that identifies a location of an input block of the electronic document prior to transmitting the electronic document to the printing device (number 116, Fig. 1, column 11, 65-67).

Having a system of Kobayashi'339 in combination with Ma'022 reference and then given the well-established teaching of Brown'805 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of signed-document creation system of Kobayashi'339 and Ma'022 as explained in claims 1, 17,

and 40 above, to include metadata as taught by Brown'805 reference because the results of the combination would have been predictable.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(US Publication No. 2003/0163785)

(US Patent No. 7,042,594)

(US Patent No. 7,227,997)

(US Publication No. 2005/0114772)

(US Patent No. 6,880,124)

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-3145. The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/  
Supervisory Patent Examiner, Art Unit 2625

LEW  
December 15, 2008